

12/13/00

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Lykos

**UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513**

Cancellation No. 28,079

Tai and Adele Aguirre  
d/b/a Taico

v.

Pamela A. Moore

Before Quinn, Walters and Wendel,  
Administrative Trademark Judges.

By the Board:

Petitioners have filed a petition to cancel  
Registration No. 2,077,612<sup>1</sup> on the grounds of priority of  
use and likelihood of confusion. Respondent, in her answer,  
denies the salient allegations of the petition for  
cancellation, and also asserts certain affirmative defenses.

This case now comes up for consideration of  
respondent's motion to dismiss the cancellation proceeding  
pursuant to Trademark Rule 2.132(a), and petitioners' cross  
motion to extend the discovery and testimony periods. The  
motions are fully briefed.

---

<sup>1</sup> Registration No. 2,077,612, for the mark YOUR SONGS for  
"musical composition for others featuring original songs for  
special occasions," issued on July 8, 1997, and reciting January  
1, 1996 as the date of first use anywhere and March 1, 1996 as  
the date of first use in commerce in connection with the  
services.

In support of her motion to dismiss, respondent argues that petitioners failed to present any testimony or other evidence during their assigned testimony period; that petitioners chose to represent themselves in this proceeding; that the mere fact that the petitioners have acted *pro se* does not excuse their ignorance of the rules; that after respondent served discovery requests, petitioners apparently retained an attorney, Mr. Martin S. Kaufman, who never filed an appearance as their attorney of record for this proceeding with the Board; that Mr. Kaufman served discovery requests on respondent five days after the close of discovery; that although Mr. Kaufman did not file an appearance in this matter, he is a licensed attorney and to the extent he assisted petitioners herein he is charged with knowledge of the necessary steps to be taken in this proceeding; and that respondent has incurred significant expense in defending its registration.<sup>2</sup>

Respondent submitted therewith a copy of an October 1, 1999 communication from Mr. Kaufman.

Petitioners filed a combined response to the motion to dismiss and cross motion to reopen the discovery and

---

<sup>2</sup> In addition, respondent alleges that petitioners' failure to file an answer to respondent's affirmative defenses constitutes a second ground for dismissing the cancellation proceeding. Inasmuch as Trademark Rule 2.106(b)(1) specifically indicates that a reply to an affirmative defense is not required, respondent's argument with regard thereto will be given no consideration.

testimony periods, essentially alleging that their failure to adhere to the trial schedule was not willful or intentional but rather the result of reliance on Mr. Kaufman; that Mr. Kaufman had volunteered to assist petitioners in preparing answers to respondent's discovery requests as well as presenting petitioners' testimony; that Mr. Kaufman was not formally retained as an attorney to represent petitioners; that Mr. Kaufman is not a patent, trademark or copyright attorney, but rather is an attorney with a non-profit public interest legal foundation in New York; that Mr. Kaufman's delay in serving the discovery requests on respondent was only five days; that Mr. Kaufman had inadvertently overlooked and misplaced the Board's January 15, 1999 scheduling order; that Mr. Kaufman was working from his inaccurate recollection of the discovery deadline, and forgot the date for the close of petitioners' testimony period; that respondent will not be prejudiced by a reopening of the case; and that petitioners should not be penalized for Mr. Kaufman's oversights.

Petitioners' response and motion are supported by the affidavit of Tai Aguirre, one of the petitioners, as well as the declaration of Mr. Kaufman.

Respondent, for her part, argues that petitioners' neglect is not excusable because petitioners disavow having retained Mr. Kaufman as an attorney to represent them in

this proceeding; and that forgetting the dates of the close of discovery and the testimony period does not constitute excusable neglect.<sup>3</sup>

Trademark Rule 2.132(a) provides that a defendant may file a motion for dismissal on the ground of failure to prosecute directed to the sufficiency of a plaintiff's trial evidence when the plaintiff has not taken testimony or offered any other evidence. In response, the plaintiff must show cause why final judgment should not be rendered against it. In the absence of a showing of good and sufficient cause, judgment may be rendered against the plaintiff. See Trademark Rule 2.132(a). The "good and sufficient cause" standard, in the context of this rule, is equivalent to the "excusable neglect" standard which would have to be met by any motion under Fed. R. Civ. P. 6(b) to reopen the plaintiff's testimony period. See *Grobet File Co. of America, Inc. v. Associated Distributors Inc.*, 12 USPQ2d 1649 (TTAB 1989); and *Fort Howard Paper Co. v. Kimberly-Clark Corp.*, 216 USPQ 617 (TTAB 1982). See also TBMP § 535.02.

As clarified by the Supreme Court in *Pioneer Investment*

---

<sup>3</sup> In her response to the motion to reopen, respondent raises the additional argument that petitioners' mark is merely descriptive as applied to their services. Inasmuch as descriptiveness of a plaintiff's asserted mark is not a ground for dismissal under Trademark Rule 2.132(a), respondent's allegation with regard thereto will be given no consideration.

*Services Company v. Brunswick Associates Limited*

*Partnership*, 507 U.S. 380 (1993), and followed by the Board in *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997), the inquiry as to whether a party's neglect is excusable is:

at bottom in an equitable one, taking account of all relevant circumstances surrounding the party's omission. These include. . . [1] the danger of prejudice to the [nonmovant], [2] the length of the delay and its potential impact on judicial proceedings, [3] the reason for the delay, including whether it was within the reasonable control of the movant, and [4] whether the movant acted in good faith.

*Pioneer*, 507 U.S. at 395. In subsequent applications of this test, several courts have stated that the third *Pioneer* factor, namely the reason for the delay and whether it was in the reasonable control of the movant, might be considered the most important factor in a particular case. See *Pumpkin Ltd.* at 1586, footnote 7 and the cases cited therein.

Considering first the third *Pioneer* factor, the reason for the delay, the Board finds that petitioners' failure to present evidence during their assigned testimony period was caused by circumstances wholly within their reasonable control. Petitioners' reliance on assistance from Mr. Kaufman does not excuse their failure to conduct discovery and take testimony in a timely manner. See *Pioneer*, 507 U.S. at 396 (a party must be held accountable for the accidental omissions of its chosen counsel, such that, for

purposes of making the excusable neglect determination, it is irrelevant that the failure to take the required action was the result of the party's counsel's neglect and not the neglect of the party itself). The instant case is similar to *Syosset Laboratories, Inc. v. TI Pharmaceuticals*, 216 USPQ 330 (TTAB 1982), wherein the Board denied opposer's Rules 60(b) motion where opposer had retained its accountant, who was also an attorney but who had no expertise in trademark law or matters before the Board, to represent it in an opposition proceeding. As the Board reasoned in finding no excusable neglect:

...opposer was under a duty to at least inquire as to whether its accountant/attorney had any knowledge regarding proceedings before the Trademark Trial and Appeal Board. It would appear to have been a simple matter for opposer to ascertain this information and to select another attorney if, in fact it became evident that counsel had no experience or knowledge whatsoever concerning matters before the Trademark Trial and Appeal Board...Rather, this appears to be merely a case of a party, voluntarily selecting an attorney who was incompetent in proceedings before the Board and the incompetence was known or should have been known to opposer.

*Id.* at 332.

Petitioners were well aware that Mr. Kaufman was not a trademark attorney. Indeed, petitioners' prior experience with Mr. Kaufman had been in his capacity in representing petitioners in a land use regulation case. Despite knowing that Mr. Kaufman had no experience in Board proceedings, petitioners decided to rely on him to assist them.

Furthermore, petitioners did not formally retain Mr. Kaufman as counsel for this proceeding. Petitioners, not Mr. Kaufman, have the sole responsibility for adhering to the deadlines in this case inasmuch as they elected to act *pro se* in this proceeding. To now assert that their failure to prosecute this case was due to the omissions of an attorney who did not even enter an appearance in this case does not constitute a showing that the reason for the delay was outside of their control.

Turning next to the second *Pioneer* factor, i.e., the length of the delay and its potential impact on this proceeding, the Board notes that petitioners' testimony period closed on October 8, 1999 and that petitioners did not file their motion to reopen until November 12, 1999, and then only after respondent filed its motion to dismiss. However, in addition to the time between the expiration of the time for taking action and the filing of the motion to reopen, the calculation of the length of the delay in proceedings also must take into account the additional, unavoidable delay arising from the time required for briefing and deciding the motion to reopen. The impact of such delays on this proceeding is not inconsiderable.

As for the first *Pioneer* factor, the danger of prejudice to respondent, the record does not indicate that respondent's ability to defend against petitioners' claims

has been prejudiced by petitioners' failure to adhere to the trial schedule. That is, there has been no showing that any of respondent's witnesses and evidence have become unavailable as a result of the delay in proceedings. See *Pratt v. Philbrook*, 109 F.3d 18 (1st Cir. 1997).

Finally, under the fourth *Pioneer* factor, there is no basis in this record for finding that petitioners' failure to present evidence during its assigned testimony period was the result of bad faith on the part of petitioners.

On balance, we find that petitioners' failure to adhere to the trial schedule in this proceeding is the dominant factor in the excusable neglect analysis in this case. Accordingly, even under the more liberal interpretation of "excusable neglect" articulated in *Pioneer* Court and adopted by the Board, such neglect can be neither overlooked nor excused.

In view thereof, petitioners' motion to reopen the discovery and testimony periods is denied.

In view of our denial of petitioners' motion to reopen, and inasmuch as petitioners failed to offer any evidence whatsoever in support of their claims during the assigned period for presentation of their case-in-chief, we find that petitioners have failed to carry their burden of proof in this case, and cannot prevail herein. Accordingly, respondent's motion for dismissal under Trademark Rule



Cancellation No. 28,079

2.132(a) is granted and the petition to cancel is dismissed with prejudice.<sup>4</sup>

---

<sup>4</sup> In view of the foregoing, respondent's untimely motion (filed December 4, 1999) for summary judgment is moot, and need be given no consideration. See Trademark Rule 2.127(e)(1).